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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/620,803

06/30/2003

Charles R. Reeves JR.

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EXAMINER

CHRISTENSEN, SCOTT B

ART UNIT

PAPER NUMBER

2144

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/620,803	REEVES ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Scott Christensen	2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This Office Action is in regards to the most recent papers filed on 6/30/2003.

***Specification***

2. The disclosure is objected to because of the following informality: Page 12, line 9 refers to "computer 20." This should apparently be "computer 110."

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 30 recites the limitation "the selection" in line 1. There is insufficient antecedent basis for this limitation in the claim. For purposes of prosecution, it is assumed that claim 30 depends from claim 29, and that "the selection" refers to the action performed by the management component in claim 29.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 20 and 35-39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With regard to claim 20, the instant claim is directed towards a computer-readable medium having computer-executable instructions. However, according to the instant specification page 9, lines 10-12, a computer-readable medium may include communication media, which may include carrier waves or other transport mechanism. Claims directed to signals are held to be nonstatutory. To be statutory, the instant claim must be limited to only computer storage media (as in the specification, page 9, lines 10-23) that stores the computer-executable instructions.

With regard to claims 35-38, each of the instant claims may be directed towards software per se. Claims 35 and 36 recite means plus function language, however, appear to include embodiments that may be implemented in software alone without any corresponding hardware (for example, claim 20 performs much of the same as claim 35, but is performed through computer-executable instructions). Claims 37 and 38 are directed to a system that comprises a service registry and a manager component, both of which clearly include embodiments which are software alone. For system claims, the scope of the claims must include only embodiments that are implemented in hardware or a combination of hardware and software, but not software alone, to be found statutory.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-10, 14, 17-23, 25-33, and 35-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Murto et al. in US Patent Application Publication US 2004/0213409 A1, hereafter referred to as "Murto."

With regard to claim 1, Murto discloses in a computing environment, a method comprising:

receiving a plurality of access points to distributed services that match specified criteria, the access points provided by a service registry (Murto: Paragraph [0158] and [0159]);

maintaining the plurality of access points in a cache (Murto: Paragraph [0169]);

receiving a request from a program to provide an access point (Murto: Paragraphs [0155] and [0169]); and

in response to the request, selecting an access point from the cache and returning data corresponding to the access point to the program (Murto: Paragraphs [0159] and [0165]).

With regard to claim 2, Murto discloses receiving the specified criteria from the program, and sending a query to the service registry based on the criteria (Murto: Paragraphs [0155] to [0158]).

With regard to claim 3, Murto discloses receiving the plurality of access points from the service registry in response to the query (Murto: Paragraph [0159]).

With regard to claim 4, Murto discloses that the service registry comprises a UDDI-based registry, and wherein the sending the query to the service registry comprises sending a UDDI find request (Murto: Paragraph [0158]).

With regard to claim 5, Murto discloses that the plurality of access points is provided by the service registry in a list of URLs, and wherein returning data corresponding to the access point comprises returning data comprising a URL (Murto: Paragraph [0144]).

With regard to claim 6, Murto discloses that returning data corresponding to the access point comprises returning a network address of a computer system (Murto: Paragraph [0144]. A URL is considered to be a type of network address.).

With regard to claim 7, Murto discloses that returning data corresponding to the access point comprises returning an identifier that can be resolved by some mechanism

to an application or a particular instance of an application (Murto: Paragraph [0144]. A URL is an identifier that can be resolved.).

With regard to claim 8, Murto discloses that receiving a request from a program for an access point comprises receiving a call at a defined interface (Murto: Paragraph [0043]. Any network communication that is received involves receiving some call at some interface (e.g. the network interface).).

With regard to claim 9, Murto discloses that selecting the access point from the cache comprises maintaining the access points in an ordering (Murto: Paragraph [0159]. As a list is returned, there is some order, even if the order is not according to any particular rule.), and choosing the access point based on the ordering (Murto: Paragraph [0022]).

With regard to claim 10, Murto discloses basing the ordering on data received from the program (Murto: Paragraph [0022]).

With regard to claim 14, Murto discloses receiving information that a distributed service has failed, and outputting failure data in response thereto (Murto: Paragraph [0081]).

With regard to claim 17, Murto discloses that outputting failure comprises communicating with an error handling service (Murto: paragraph [0081]).

With regard to claim 18, Murto discloses collecting failure information at the error handling service (Murto: Paragraph [0081]).

With regard to claim 19, Murto discloses receiving information that a distributed service has failed comprises receiving a call at a defined interface (Murto: Paragraph [0081]).

With regard to claim 20, Murto discloses a computer readable medium having computer-executable instructions for performing the method of claim 1 (Murto is a computer implemented system, so it inherently has some computer readable medium with some instructions for performing the method of claim 1.).

With regard to claim 21, the instant claim is substantially similar to subject matter presented in claim 1, and is rejected for substantially similar reasons.

With regard to claim 22, Murto discloses that the manager component comprises an instantiated object (Murto: Paragraphs [0154-0168]. The server, which performs many of the functions of the manager component, comprises an instantiated object, as the server, and modules within the server, exists.).



With regard to claim 23, the instant claim is substantially similar to subject matter presented in claim 5, and is rejected for substantially similar reasons.

With regard to claim 25, Murto discloses that the manager component is coupled to the client program via a defined interface that receives the request for the access point (Murto: Figure 6. The server receives information via the network.).

With regard to claim 26, the instant claim is substantially similar to subject matter presented in claim 4, and is rejected for substantially similar reasons.

With regard to claim 27, the instant claim is substantially similar to subject matter presented in claims 2 and 3, and is rejected for substantially similar reasons.

With regard to claim 28, the instant claim is substantially similar to subject matter presented in claim 4, and is rejected for substantially similar reasons.

With regard to claim 29, the instant claim is substantially similar to subject matter presented in claim 9, and is rejected for substantially similar reasons.

With regard to claim 30, the instant claim is substantially similar to subject matter presented in claim 9, and is rejected for substantially similar reasons.

With regard to claim 31, the instant claim is substantially similar to subject matter presented in claim 19, and is rejected for substantially similar reasons.

With regard to claim 32, the instant claim is substantially similar to subject matter presented in claim 14, and is rejected for substantially similar reasons.

With regard to claim 33, the instant claim is substantially similar to subject matter presented in claim 18, and is rejected for substantially similar reasons.

With regard to claim 35, the instant claim is substantially similar to subject matter presented in claim 1, and is rejected for substantially similar reasons.

With regard to claim 36, the instant claim is substantially similar to subject matter presented in claims 14, and 17-19, and is rejected for substantially similar reasons.

With regard to claim 37, the instant claim is substantially similar to subject matter presented in claims 1-3, and is rejected for substantially similar reasons.

With regard to claim 38, the instant claim is substantially similar to subject matter presented in claims 4-5, and is rejected for substantially similar reasons.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 11-13, 15-16, 24, and 34 rejected under 35 U.S.C. 103(a) as being unpatentable over Murto in view of Official Notice.

With regard to claim 11, Murto discloses the invention as substantially claimed except basing the ordering on quality of service data.

However, Official Notice (See MPEP §2144.03) is taken that this functionality is well known in the art.

The Applicant is entitled to traverse any/all Official Notice taken in this action according to MPEP §2144.03. However, MPEP §2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)."

Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Alhert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of this assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed." Further note that 37 CFR §1.67(c)(3) states "Judicial notice means

official notice." Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

It would have been obvious to base the order on quality of service data.

The suggestion/motivation for doing so would have been that Murto provides for ordering of items on the list based on user preferences (Murto: Paragraph [0170]). Allowing the list to be sorted based on quality of service parameters (e.g. reliability or current status) allows the user to give preference to service providers that are capable of providing the services at an acceptable reliability.

With regard to claim 12, Murto discloses the invention as substantially claimed except choosing the access point based on the ordering comprises choosing the access point that is first in the ordering of those access points that have not been marked as having failed.

However, Official Notice (See MPEP §2144.03) that this functionality was well known in the art.

It would have been obvious to select the access point that is first in the list that has not been marked as having failed.

The suggestion/motivation for doing so is that the list of Murto is sorted based on user preferences (Murto: Paragraph [0170]). As such, the top item would be the closest match to the desired settings of the user. Further, it would not make sense to choose the top access point in the list if it is known to have failed, so the first access point that

is not known to have failed would be the access point that is closest to the user's preference that can be accessed by the user.

With regard to claim 13, the instant claim is substantially similar to subject matter presented in claim 12 (the "access point that is next" is interpreted as being the first access point, as in claim 12), and is rejected for substantially similar reasons.

With regard to claim 15, Murto discloses the invention as substantially claimed except updating the service registry based on failure data.

However, Official Notice (See MPEP §2144.03) that this functionality was well known in the art.

It would have been obvious to update the service registry based on the failure data.

The suggestion/motivation for doing so would have been that if an access point fails, the registry would still advertise the access point as having the service (and presumably be available), while the access point is, in fact, unavailable. Thus, having a mechanism to mark the access point as failed or remove the access point from the registry would allow the service registry to advertise only those access points that are believed to be active.

With regard to claim 16, Murto discloses the invention as substantially claimed except updating information relative to the cache based on failure data to indicate that the service has failed.

However, Official Notice (See MPEP §2144.03) that this functionality was well known in the art.

It would have been obvious to update the cache based on the failure data.

The suggestion/motivation for doing so is similar to the motivation presented with regard to claim 15. Either the cache could be updated directly, as to avoid presenting the information to the user without requiring that the registry be updated, or the cache would be updated with regard to the current state of the registry, meaning that the cache would be updated based on the failure data.

With regard to claim 24, Murto discloses the invention as substantially claimed except that the client program hosts the manager component.

However, according to MPEP 2144.04 VI, the mere rearrangement of parts (e.g. the location of the manager component) may be an obvious matter of design choice.

It would have been obvious to a person of ordinary skill in the art to choose to have the manager component hosted on the client program rather than on a separate system.

The suggestion/motivation for doing so would have been that the client would have a local cache, and would not have to rely on a separate server to perform the caching and request operations. Rather, the client could directly retrieve the information

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on the location of the access point that was previously retrieved (possibly as part of a previous request), and access the service using that information. This would increase the efficiency of the system of Murto for the single client.

With regard to claim 34, the instant claim is substantially similar to subject matter presented in claims 15 and 18, and is rejected for substantially similar reasons.


**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Christensen whose telephone number is (571) 270-1144. The examiner can normally be reached on Monday through Thursday 6:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vaughn William can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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